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SENT TO: Mr. Ding Dem  
571 273-1462

DATE SENT: Dec 15, 2003

SUBJECT: 09/423,675 ; Jacquinet = 7

No. of pages (including this cover sheet): 5

FROM: Sheridan Neimark

## Remarks:

Per your request, attached is the RCE and attachment.  
 Please advise if you need the postcard receipt. (Not attached  
 to this fax is PTO-2038, payment form)

Browdy and Neimark

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

ATTY.'S DOCKET: JACQUINOT=7

In re Application of:	)	Art Unit: 1765
Eric JACQUINOT	)	Examiner: D. DEO
Appln. No.: 09/427,675	)	Washington, D.C.
Date Filed: October 27, 1999	)	Confirmation No. 3607
For: NEW ABRASIVE COMPOSITION	)	August 1, 2003
FOR THE INTEGRATED...	)	

**REQUEST FOR ENTRY OF DECLARATION**

Mail Stop \_\_\_\_\_  
Honorable Commissioner for Patents  
2011 South Clark Place  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Sir:

Applicants are in receipt of Paper No. 25, an  
Advisory Action mailed July 24, 2003, which states in the last  
line thereof as follows:

The Declaration by Dr. Jacquinot is  
acknowledged; however, it has not been  
considered because of untimely filing.

Applicants request entry and consideration of such  
Declaration.

First, applicants respectfully note that such  
Declaration was filed with a Request for Reconsideration filed  
July 14, 2003, and the Notice of Appeal was not filed until

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one day later, namely on July 15, 2003. The Rule in question is 37 CFR 1.195 which states in part that

... declarations... submitted **after** the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented. (emphasis added)

Thus, according to said Rule 195, a showing is only required if a Declaration is submitted **after** filing an appeal, but the clear implication is that no such showing is required **before** an appeal is filed, as in the present case. Accordingly, consistent with Rule 195, the Declaration of Dr. Jacquinet which was filed a day before the appeal was filed is timely rather than untimely filed, and should be entered.

Nevertheless, so that there will be no doubt, applicants have good and sufficient reasons why such Declaration was not presented earlier, as follows:

The Grover et al USP '917 was cited for the first time in the Office Action mailed April 10, 2002. Applicants replied with what they considered to be strong arguments against the rejection on December 26, 2002, at that time believing their arguments would overcome the rejection, and that no costly experiments would have to be conducted.

It was only when the rejection was repeated in the final Action mailed January 15, 2003, that applicants realized that they would need to have expensive comparative tests

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conducted to support their position, and consequently the testing procedure was not begun until after issuance of such Final Rejection mailed January 15, 2003.

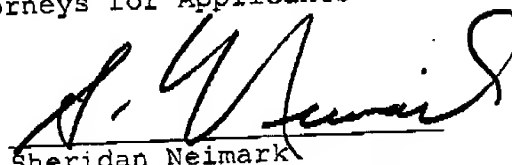
The cost of such experiments and the fact that applicants previously believed that no such tests would be necessary constitute good and sufficient reasons why the tests which resulted in the Declaration were not conducted earlier. Upon completion of these tests, the Declaration was filed on, as indicated, July 14, 2003.

Applicants request that such Declaration be entered at least for purposes of applicants' Appeal.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicants

By



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